

## REMARKS

On September 27, 2007, an office action issued wherein the Examiner rejected claims 1-5 under 35 U.S.C. 103(as) as obvious over Lam in view of Deluxe. The examiner states that the claimed invention is taught by Lam save for an Internet based check ordering system which is provided by Deluxe. Specifically, it is stated:

Referring to Claim 1: Lam teaches an Internet-based check system, including: a client computer system; an Internet-based server having a check order entry user interface remote from and in operable communication with said client computer system (Lam: Abstract; Figures 1-3, #14; Page 2, Paragraphs 0031-0034//Lam shows an Internet-based check system consisting of a client terminal//), wherein said Internet based server includes software for enabling input at said interface of client data (Lam:

Figure 10; Page 6, Paragraph 0061//Lam teaches a system which uses a Internet based server in order to enable receipt of input at the client terminal device/I), and a printing station in operable communication with said Internet-based server computer system to print checks bearing said data thereon (Lam: Abstract; Page 1, Paragraphs 0002, 0006-0011, 00 14//Lam discloses a system which prints checks to remote locations//).

Lam, however; does not expressly teach an Internet-based check ordering system, including: client check number data, client bank transit number data, client bank account data, and client bank routing data at said check order user interface and has means for transmitting said bank client bank transit number data, said client bank account data, and said client bank routing data in an encrypted manner; a bank transit number computer system remote from and in operable communication with the Internet- based server computer system having software for receiving at least said client bank transit number data, said client bank account data, and said client bank routing data from said Internet-based server and de-encrypting said client bank transit number data, said client bank account data, and said client bank routing data, and comparing at least said client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system to verify that said client bank transit number corresponds to. bank transit data in said database, and transmits to said Internet- based server verified check print data which includes said client bank transit number data, said client bank account data, and said client bank routing data and a predetermined printing orientation.

Deluxe, in a similar environment, discusses an Internet-based check ordering system, including: client check number data, client bank transit number data, client bank account data, and client bank routing data at said check order user interface and has means for transmitting said bank client bank transit number data, said client bank account data, and said client bank routing data in an

encrypted manner (Deluxe: Pages- I-IV Deluxe displays a system which allows a user to input a check number associated with a check and financial banking institution as well as account/routing information affiliated with a users account/I); a bank transit number computer system remote from and in operable communication with the Internet-based server computer system having software for receiving at least said client bank transit number data, said client bank account data, and said client bank routing data from said Internet-based server and de-encrypting said client bank transit number data, said client bank account data, and said client bank routing data, and comparing at least said client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system to verify that said client bank transit number corresponds to bank transit data in said database (Deluxe:

Page II/Deluxe displays a system which employs a terminal unit in order for a user to enter associated account information and performs a verification procedure to verify user/I), and transmits to said Internet- based server verified check print data which includes said client bank transit number data, said client bank account data, and said client bank routing data and a predetermined printing orientation (Deluxe: Pages I–IV//Upon complete system transaction, a user is able to print the checks as requested//).

At the time of invention it would have been obvious to modify the method of Lam by incorporating a feature for ordering checks with the invention of Deluxe in order to effectively create an online Internet-based check ordering system as disclosed for the purpose of increasing customer access to personal checks, etc. (Deluxe: Pages I–III).

Referring to Claim 2: Deluxe discusses the limitations as set forth in Claim 1.

Deluxe, however, does not explicitly show an Internet-based check system, wherein software on said Internet-based server includes means for billing a client at said user interface using said system.

Lam discusses an Internet-based check system, wherein software on said Internet-based server includes means for billing a client at said user interface using said system (Lam: Figure 8; Page 2, Paragraph 0017; Page 3, Paragraph 0037; Page 6, Paragraph 0065//Lam shows an Internet-based check server and system where a user is provided with a billing interface//).

At the time of invention it would have been obvious to modify the method of Lam by incorporating a feature for ordering checks with the invention of Deluxe in order to effectively create an online Internet-based check ordering system as disclosed for the purpose of increasing customer access to personal checks, etc. (Deluxe: Pages I–III).

Referring to Claim 3: Deluxe teaches the limitations as set forth in Claim 1.

Deluxe, however, does not show an Internet-based check system, wherein said Internet-based server is operably associated with a database which contains and stores said client data, said client check number data, said client bank transit number data, said client bank account data and said client bank routing data.

Lam, in a similar environment, expressly states and shows an Internet-based check system, wherein said Internet-based server is operably associated with a database which contains and stores said client data, said client check number data, said client bank transit number data, said client bank account data and said client bank routing data (Lam: Figures 1-3; Claim 10//Lam shows an Internet-based check system which utilizes a server in conjunction with a database that stores information related to client [user] information//)..

At the time of invention it would have been obvious to modify the method of Lam by incorporating a feature for ordering checks with the invention of Deluxe in order to effectively create an online Internet-based check ordering system as disclosed for the purpose of increasing customer access to personal checks, etc. (Deluxe: Pages I—III).

Referring to Claim 4: Deluxe discloses the limitations as set forth in Claim 1.

Deluxe, however, does not disclose an Internet-based check system, wherein said Internet-based server is further equipped to associate said received verified check information data from said bank transit number computer system with said client data, said client check number data, said client bank transit number data, said client bank account data and said client bank routing data.

Lam teaches an Internet-based check system, wherein said Internet-based server is further equipped to associate said received verified check information data from said bank transit number computer system with said client data, said client check number data, said client bank transit number data, said client bank account data and said client bank routing data (Lam: Claims 1-10//Lam describes an Internet-based system where the Internet-based server is capable of associating user check information data//).At the time of invention it would have been obvious to modify the method of Lam by incorporating a feature for ordering checks with the invention of Deluxe in order to effectively create an online Internet-based check ordering system as disclosed, for the purpose of increasing customer access to personal checks, etc. (Deluxe: Pages I—III).

Referring to Claim 5: Deluxe discloses the limitations as set forth in Claim 1.

Deluxe, however, does not teach an Internet-based check system, wherein said printing station includes a computer which is operably connected to said Internet-based server in a manner to receive said client data, said client check number data, said client bank transit number data, said client bank account data, said client bank routing data and said verified, check print data in an encrypted form and de-encrypts said data to enable printing of said checks.

Lam, in a similar environment, shows an Internet-based check system, wherein said printing station includes a computer which is operably connected to said Internet-based server in a manner to receive said client data, said client check number data, said client bank transit number data, said client bank account data, said client bank routing data and said verified check print data in an encrypted form and de-encrypts said data to enable printing of said checks (Lam: Abstract; Page 1, Paragraphs 0002, 0006-0011, 0014//Lam discloses an Internet-based check system connected in a manner for reception of client data//).

At the time of invention it would have been obvious to modify the method of Lam by incorporating a feature for ordering checks with the invention of Deluxe in order to effectively create an online Internet-based check ordering system as disclosed for the purpose of increasing customer access to personal checks, etc. (Deluxe: Pages I—III).

#### Claimed Invention

To reiterate, the present invention calls for:

An Internet-based check ordering and reordering system, including:

a client computer system;

an Internet-based server having a check order entry user interface remote from and in operable communication with the client computer system, wherein the Internet-based server includes software for enabling input at the interface of client data, client check number data, client bank transit number data including bank branch name, address and branch number, client bank account data, and client bank routing data at the check order user interface and has means for transmitting the bank client bank transit number data, the client bank account data, and the client bank routing data in an encrypted manner;

a bank transit number computer system remote from and in operable communication with the Internet-based server computer system having software for receiving at least the client bank transit number data, the client bank account data, and the client bank routing data from the Internet-based server and de-encrypting the client bank transit number data, the client bank account data, and the client bank routing data, and comparing at least the client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of the bank transit number computer system to verify that the client bank transit number corresponds to bank transit

data in the database, and transmits to the Internet- based server verified check print data which includes the client bank transit number data, the client bank account data, and the client bank routing data and a predetermined printing orientation; and

a printing station in operable communication with the Internet-based server computer system to print checks bearing the data thereon and a blank amount field.

The examiner acknowledged that neither reference teaches, suggests, or discloses the claimed invention. Rather, the combination is submitted as a means of rendering obvious the claimed invention. To this end, the examiner provides a screenshot of a Deluxe web site in combination with the teaching of Lam.

Applicant respectfully submits that neither reference alone or in combination with the other teaches, suggests or discloses the invention. Lam simply discloses a system and apparatus for remotely printing certified documents. Particularly, Lam teaches a communication system for remotely and securely printing certified checks via the Internet and includes a customer communication device operative to initiate communication with a web server which is in communication with a system bank capable of creating an image file of the certified check which is securely encrypted and transmitted back to the customer via the Internet. Lam prints a “certified check” from a bank at a site remote to the bank wherein the remote site must have respective printing apparatus 15 (FIGS. 2 and 3) capable of printing certified documents. An encrypted image file of the requested certified check will be received at the customer location and printed using bank specified printer on pre-numbered check paper, which is issued by the bank and securely stored in the printer. This in no way teaches the claimed invention.

Also, the cited screenshot of Deluxe appears to teach no more than what was

known prior to the claimed invention. That is, Deluxe, provides a site to facilitate the order of checks by partnered relationships with financial institutions. This is similar to a middle man operation wherein local printers are affiliated with the banks and perform the printing of checks for a particular bank and the web site appears to do no more than facilitating this.

Notably missing from the cited reference(s) is any teaching, disclosure or suggestion of the need for obtaining local bank information, address, branch number in addition to the other bank and client information. Also missing is the element of the instant invention which compares at least the client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of the bank transit number computer system to verify that the client bank transit number corresponds to bank transit data in the database (i.e., the database being federally provided). This information is required in order to perform a validation and goes to the heart of the instant invention. By so providing, there is not only a reduced chance of misinformation but also a mechanism in which to more securely and accurately speed the process of check ordering and reordering. Further, there is provided a mechanism by which to reduce printing costs through reduced printing error and increased competition local printers. Currently, local banks have established relationships with a printer and govern the cost of check book reorders through these relatively noncompetitive relationships.

None of the prior art provides the claimed elements of the instant invention. The references fail to teach the instant invention and it is a great leap to imply that the combination of references teach this. There is simply no discussion, disclosure,

suggestion or teaching whatsoever to do so, absent the instant invention.

It is recognized that the nonobviousness requirement extends the field of unpatentable material beyond that which is known to the public under § 102, to include that which could readily be deduced from publicly available material by a person of ordinary skill in the pertinent field of endeavor. See *Graham*, 383 U.S., at 15, 86 S. Ct., at 692. As noted in 550 U. S. \_\_\_\_ (2007), Opinion of the Court ... SUPREME COURT OF THE UNITED STATES. No. 04-1350. KSR INTERNATIONAL CO., PETITIONER v. TELEFLEX INC., the Federal Circuit's so-called "teaching- suggestion-motivation" standard for obviousness is also a helpful though not determinative test, wherein there must be some motivation or suggestion to combine specific prior art in such a way as to arrive at the particular combination disclosed in the patent at issue. See, e.g., *Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000), cert. denied, 532 U.S. 974 (2001) *Ashland Oil*, 776 F.2d at 293, and that teaching- suggestion-motivation cannot come from the invention, i.e., prevention of hindsight use.

The issue is here is whether Lam and/or Deluxe and some other knowledge (presumably the Examiner's) brought here together renders obvious claimed invention. The Federal Circuit has followed the Court's holding in *Adams*. See, e.g., *Kahn v. General Motors Corp.*, 135 F.3d 1472, 1479-80 (Fed. Cir. 1998), cert. denied, 525 U.S. 875 (1998) ("In determining obviousness, the invention must be considered as a whole?").

Set aside Lam and Deluxe which Applicant asserts do not teach the invention, no other evidence has been put forth which teach, suggest or disclose the invention. Combining the references does no more than provide separate technologies which enable a user to order and/or reorder personal and business checks on the aforementioned

manner.

Applicant has adequately rebutted the examiner's contention. It is respectfully submitted that the cited art, namely, Lam and Deluxe, do not render obvious the instant invention, to produce the claimed present invention. Combining Lam with Deluxe's teachings is not intuitive nor does it make sense or render the present invention as it is not understood why one would combine such teachings as they perform completely different tasks, i.e., Lam to send a single certified check to conduct a transaction such as a purchasing real estate verses Deluxe as a facilitator to reordering checks through the person's bank.

The differences between the prior art and claimed invention are very apparent. The level of ordinary skill in the art in the field of check book fulfillment has not been established and cannot be asserted without some reasonable basis for doing so.

Claims 1-5 are respectfully submitted to be patentably distinct over the cited art. Withdrawal of the rejection of claims 1-5 is kindly requested.

Accordingly, allowance of claims 1-5 is respectfully requested at as early a date as possible. This is intended to be a complete response to the Office Action of 9/27/2007. Respectfully submitted,

/R. William Graham/

R. William Graham

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Certificate of transmission

I hereby certify that this Amendment is being electronically filed with the Commissioner of Patent and Trademarks, Washington, D.C. 20231 on the date shown below.

Date. December 27, 2007 /R. William Graham/ R. William Graham